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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,128	01/24/2001	Brian B. Cuyler	M 6691 HST CCAE-COIL	5560

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HENKEL CORPORATION  
2500 RENAISSANCE BLVD  
STE 200  
GULPH MILLS, PA 19406

EXAMINER

WESSMAN, ANDREW E

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 04/11/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-4

**Office Action Summary**

Application No.

09/769,128

Applicant(s)

CUYLER ET AL.

Examiner

Andrew E Wessman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s): \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a composition, classified in class 148, subclass 22.
- II. Claims 6-20, drawn to a surface treating process, classified in class 148, subclass 251.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed could be used in a process where it is not painted over.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Stephen Harper on March 29, 2002 a provisional election was made with traverse to prosecute the invention of group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Endo et al. (U.S. Patent No. 5,232,523).

Endo et al. anticipates the claimed invention. Endo et al. discloses (see table 1, especially examples 1-5, and claims 1 and 2) a dry in place liquid phosphating composition having 0.1 to 2.0 g/l of zinc ions, 5 to 40 g/l of phosphate ions, and inorganic oxides of at least one of silicon, aluminum, titanium, and zirconium.

In regards to the features of claim 2, Endo et al. teaches (see claim 2 and table 1) 0.5 to 1.0 g/l of colloidal oxide particles of alumina, silica, and zirconia.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. in view of applicant supplied translation of WO 97/45568.

The teachings of Endo et al. are discussed in above paragraph 6. Endo et al. also teaches (see table 1 and claim 1) concentrations of manganese ions from 0.1 to 3 g/l and concentrations of nickel ions from 0.1 to 6 g/l.

Endo et al. does not teach adding iron ions or hydroxylamine to a phosphating composition.

WO 97/45568 teaches (page 8, line 12 of the supplied translation) the addition of hydroxylamine to phosphating compositions because of its use as an accelerator, and teaches (see claim 1) adding hydroxylamine in an amount ranging from 0.1 to 10 g/l.

It would have been obvious to one of ordinary skill in the art to add hydroxylamine as taught by WO 97/45568 to the phosphating composition of Endo et al. because WO 97/45568 teaches that hydroxylamine is useful as an accelerator in such compositions (page 8, line 12).

In regards to the features of claim 4, the teachings of Endo et al. have been discussed above with regard to phosphate, zinc, manganese, and nickel concentrations.

Endo et al. does not teach the addition of calcium ions to a phosphating compound, nor does Endo et al. teach the addition of amino-phenolic polymers to phosphating compositions.

WO 97/45568 teaches (page 8, lines 27-30) that calcium may be added to phosphating compositions to increase hardness. WO 97/45568 also teaches (page 9, lines 10-13) adding organic polymers to phosphating compositions for the purpose of passivation, and teaches (page 9, line 25-page 10, line 9) that amino compounds of various types which can include phenolic compounds. As shown from the chemical structure on page 9, the scope of the amino compounds taught by WO 97/45568 would include compounds meeting the requirements of the claimed invention.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add calcium and an aminophenolic polymer to the phosphating compound taught by Endo et al., because one of ordinary skill in the art would expect an increase in hardness and passivation as taught by WO 97/45568 (page 9, lines 10-13).

With regards to the features of claim 5, Endo et al. does not teach the addition of an acrylic polymer to the phosphating composition.

WO 97/45568 teaches (page 13, lines 8-11) that polymers of various acrylic compounds could be used in phosphating compositions. While WO 97/45568 does not explicitly teach the specific properties of the acrylic polymers to be used in the phosphating compositions, the scope of WO 97/45568 would include such polymers that would inherently possess the properties recited in the claimed invention.

It would have been obvious to add an acrylic polymer as taught by WO 97/45568 to the phosphating composition of Endo et al., because it would be useful for surface passivation as taught by WO 97/45568 (page 9, lines 10-13).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is (703)305-3163. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

AEW  
April 8, 2002

  
**ROY KING**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1700**